UNITED STATES PATENT AND TRADEMARK OFFICE

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10/612,970	07/07/2003	David W. Holmes	12177/69001	4732

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EXAMINER
PHUONG, DAI

ART UNIT	PAPER NUMBER
2617	

DATE MAILED: 11/03/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

	Application No.	Applicant(s)
	10/612,970	HOLMES, DAVID W.
Office Action Summary	Examiner	Art Unit	
	Dai A. Phuong	2617	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on <u>06 September 2006</u>.

2a) ☒ This action is **FINAL.**   2b) ☐ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) <u>1-36 and 38-63</u> is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) <u>1-36 and 38-63</u> is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☒ The drawing(s) filed on <u>07 July 2003</u> is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a) ☐ All b) ☐ Some * c) ☐ None of:

      1. ☐ Certified copies of the priority documents have been received.

      2. ☐ Certified copies of the priority documents have been received in Application No. _____.

      3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date _____.

4) ☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____.

5) ☐ Notice of Informal Patent Application

6) ☐ Other: _____.

DETAILED ACTION

Response to Arguments

1.   Applicant's arguments with respect to claims have been considered but are moot in view

of the new ground(s) of rejection. Claim 37 has been canceled. Claims 1-36 and 38-63 are

currently pending.

Claim Rejections - 35 USC § 102

2.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the

basis for the rejections under this section made in this Office action:

> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on
> sale in this country, more than one year prior to the date of application for patent in the United States.

3.   Claims 1-2, 8-19, 21-24, 28-31, 33, 36, 38, 42-46 and 50-57 are rejected under 35

U.S.C. 102(b) as being anticipated by Lunsford et al. (Pub. No: 2002/0065041).

Regarding claim 1, Lunsford et al. disclose a method comprising:

generating a dialing request at a remote control device 12 based on an operation of a

dedicated control of the remote control device 12, the dedicated control dedicated to generating

the dialing request to transmit a dialing signal to a mobile communication device 14 (fig. 1,

[0057] to [0059]. Specifically, Lunsford et al. disclose the ___PID 12___ can accept input from a user,

such as selecting a specific contact using contact management program 101, and automatically

dial a telephone number stored in its memory via a wireless communication with ___telephone 14___.

The wireless link 20 enables applications executed on PID 12 (e.g., address book program 109)

___to access the telephone 14___ and automatically dial the number stored in the application (e.g.,

within memory 40). ___The wireless link 20 enables an application executing on PID 12 to access___

telephone 14, communicate the desired telephone number, and control telephone 14 to dial the number and established the telephone call); and

transmitting the dialing signal from the remote control device 12 toward the mobile communication device 14 based on the dialing request, the dialing signal instructing the mobile communication device to access a network-based communication service (fig. 1, [0065] to [0067]. Specifically, Lunsford et al. disclose a *wireless link 20* has been established between the *PID 12* and *the telephone 14*. After establishing, the user can select the desired individual/organization to contact. From the list, the user selects the desired contact. After selection of the desired contact, the user verifies the specific number to dial. The user confirms the wireless autodial to the specific number. *The PID 12 is using a wireless communication link 20 to transfers the specific number to telephone 14. Subsequently, PID 12 controls telephone 14 to dial the specific number and complete the telephone communication*. Thus, the user's handheld PID 12 can automatically instruct a cellphone 14 to dial a telephone number stored in the PID's memory. It should be noted that in order to dial the telephone number stored in the PID's memory, the PID 12 automatically instructs the telephone 14 communicates with a network-base communication service and/or a base station, in order to establish a connection between the PID 12 and other party).

Regarding claims 2, Lunsford et al. disclose all the limitations in claims 1. Further, Lunsford et al. disclose the method wherein the dialing request is initiated by a user manipulation of an access button of the remote device ([0057] to [0059] and [0064] to [0067]).

Regarding claim 24, this claim is rejected for the same reason as set forth in claim 2.

Regarding claim 45, this claim is rejected for the same reason as set forth in claim 2.

Regarding claim 53, this claim is rejected for the same reason as set forth in claim 2.

Regarding claim 55, this claim is rejected for the same reason as set forth in claim 2.

Regarding claim 57, this claim is rejected for the same reason as set forth in claim 2.

Regarding claims 8 and 42, Lunsford et al. disclose all the limitations in claims 1 and 36 respectively. Further, Lunsford et al. disclose the method wherein the dialing signal includes a telephone number associated with the network-based communication service, the method further including retrieving the telephone number from a memory of the remote control device ([0026], [0057] to [0059] and [0064] to [0067]).

Regarding claim 9, Lunsford et al. disclose all the limitations in claim 8. Further, Lunsford et al. disclose the method further including storing the telephone number to the memory before generating the dialing request ([0026], [0057] to [0059] and [0064] to [0067]).

Regarding claim 10, Lunsford et al. disclose all the limitations in claim 9. Further, Lunsford et al. disclose the method further including storing the telephone number to the memory based on input from a user of the mobile communication device ([0026], [0057] to [0059] and [0064] to [0067]).

Regarding claim 11, Lunsford et al. disclose all the limitations in claim 9. Further, Lunsford et al. disclose the method further including storing the telephone number to the memory based on input from a provider of the network-based communication service ([0060] to [0061]).

Regarding claim 12, Lunsford et al. disclose all the limitations in claim 9. Further, Lunsford et al. disclose the method wherein storage of the telephone number to the memory is initiated by the provider of the network-based communication service ([0060] to [0061]).

Regarding claim 13, Lunsford et al. disclose all the limitations in claim 9. Further, Lunsford et al. disclose the method wherein storage of the telephone number to the memory is initiated by a user of the remote control device ([0060] to [0061]).

Regarding claim 14, Lunsford et al. disclose all the limitations in claim 9. Further, Lunsford et al. disclose the method further including storing the telephone number to the memory based on input from a manufacturer of the remote control device ([0060] to [0061]).

Regarding claim 15, Lunsford et al. disclose all the limitations in claim 9. Furthver, Lunsford et al. disclose the method further including verifying authorization to write to the memory before storing the telephone number ([0061]).

Regarding claims 16 and 28, Lunsford et al. disclose all the limitations in claims 1 and 23 respectively. Further, Lunsford et al. disclose the method wherein the transmitting of the dialing signal occurs over a wireless connection with the mobile communication device ([0029] to [0036] and [0045] to [0052]).

Regarding claims 17 and 29, Lunsford et al. disclose all the limitations in claims 16 and 28 respectively. Further, Lunsford et al. disclose the method wherein the wireless connection is a radio frequency (RF) connection ([0029] to [0036] and [0045] to [0052]).

Regarding claims 18, 30 and 43, Lunsford et al. disclose all the limitations in claims 17, 29 and 36 respectively. Further, Lunsford et al. disclose the method wherein the transmitting of the dialing signal occurs in accordance with a Bluetooth standard ([0029] to [0036] and [0045] to [0052]).

Regarding claims 19 and 31, Lunsford et al. disclose all the limitations in claims 17 and 28 respectively. Further, Lunsford et al. disclose the method wherein the wireless connection is an infrared (IR) connection ([0029] to [0036] and [0045] to [0052]).

Regarding claims 21 and 50, Lunsford et al. disclose all the limitations in claims 1 and 44 respectively. Further, Lunsford et al. disclose the method wherein the mobile communication device is a personal digital assistant (PDA) configured for wireless communication ([0026] to [0030]).

Regarding claims 22 and 51, Lunsford et al. disclose all the limitations in claims 1 and 44 respectively. Further, Lunsford et al. disclose the method wherein the mobile communication device is a wireless phone ([0026] to [0030]).

Regarding claim 23, this claim is rejected for the same reason as set forth in claim 1.

Regarding claim 33, Lunsford et al. disclose a method of accessing a network-based communication service comprising:

verifying authorization to write to a memory of a remote control device ([0061]);

storing a telephone number to the memory of the remote control device, the telephone number being associated with the network-based communication service ([0061]);

generating a dialing request based on user input of the remote control device 12, the

dialing request being initiated by a user manipulation of an access button that is dedicated to

transmitting a dialing signal to a mobile communication device 14 (fig. 1, [0057] to [0059].

Specifically, Lunsford et al. disclose the *PID 12* can accept input from a user, such as selecting a

specific contact using contact management program 101, and automatically dial a telephone

number stored in its memory via a wireless communication with *telephone 14*. The wireless link

20 enables applications executed on PID 12 (e.g., address book program 109) *to access the*

telephone 14 and automatically dial the number stored in the application (e.g., within memory

40). *The wireless link 20 enables an application executing on PID 12 to access telephone 14*,

communicate the desired telephone number, and control telephone 14 to dial the number and

established the telephone call); and

transmitting the dialing signal from the remote control device 12 toward the mobile

communication device 14 based on the dialing request, the dialing signal including the telephone

number and instructing the mobile communication device to access a network-based

communication service (fig. 1, [0065] to [0067]. Specifically, Lunsford et al. disclose a *wireless*

link 20 has been established between the *PID 12* and *the telephone 14*. After establishing, the

user can select the desired individual/organization to contact. From the list, the user selects the

desired contact. After selection of the desired contact, the user verifies the specific number to

dial. The user confirms the wireless autodial to the specific number. *The PID 12 is using a*

wireless communication link 20 to transfers the specific number to telephone 14.

Subsequently, PID 12 controls telephone 14 to dial the specific number and complete the

telephone communication. Thus, the user's handheld PID 12 can automatically instruct a

cellphone 14 to dial a telephone number stored in the PID's memory. It should be noted that in order to dial the telephone number stored in the PID's memory, the PID 12 automatically instructs the telephone 14 communicates with a network-base communication service and/or a base station, in order to establish a connection between the PID 12 and other party).

Regarding claim 36, this claim is rejected for the same reason as set forth in claim 1.

Regarding claim 38. Lunsford et al. disclose all the limitations in claim 36. Further, Lunsford et al. disclose the remote control device wherein the user interface has no buttons other than the access button ([0045] to [0050] and [0057] to [0059]).

Regarding claim 44, Lunsford et al. disclose a mobile communication device comprising:

a phone communication module, the phone communication module to receive, from the remote control device, a dialing signal that is based on an operation of a dedicated control of the remote control device , the dedicated control dedicated to generating a dialing request to transmit the dialing signal to the mobile communication device ([0026] to [0036] and [0056] to [0062]); and

a wireless transceiver coupled to the phone communication module, the wireless transceiver to access a network-based communication service in response to the dialing signal ([0026] to [0036] and [0056] to [0062]).

Regarding claim 46, Lunsford et al. disclose all the limitations in claim 44. Further, Lunsford et al. disclose the mobile communication device further including a memory to store a telephone number associated with the network-based communication service, the wireless

transceiver to use the telephone number to access the network-based communication service in

response to the dialing signal ([0056] to [0059] and [0064] to [0067]).

Regarding claim 52, this claim is rejected for the same reason as set forth in claim 1.

Regarding claim 54, this claim is rejected for the same reason as set forth in claim 1.

Regarding claim 56, this claim is rejected for the same reason as set forth in claim 1.

Claim Rejections - 35 USC § 103

4.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in
> section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are
> such that the subject matter as a whole would have been obvious at the time the invention was made to a person
> having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the
> manner in which the invention was made.

5.   Claims 3-5, 25-27, 34-35, 39-41, 47-49 and 58-61 are rejected under 35 U.S.C. 103(a) as

being unpatentable over Lunsford et al. (Pub. No: 2002/0065041) in view of Holt et al. (Pub.

No: 20050113074).

Regarding claims 3, 25, 39, 47 and 58, Lunsford et al. disclose all the limitations in

claims 1, 23, 36, 44 and 56 respectively. However, Lunsford et al. do not disclose the method

wherein the network-based communication service is a voice information service, the voice

information service enabling a user to use information retrieval at a network server.

In the same field of endeavor, Holt et al. disclose the method wherein the voice-

controlled service is a voice information service, the voice information service enabling a user to

use information retrieval at a network server ([0060] to [0061]).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the personal information device of Lunsford et al. by specifically including Holt et al. disclose the method wherein the voice-controlled service is a voice information service, the voice information service enabling a user to use information retrieval at a network server, as taught by Holt et al., the motivation being in order to reduce network costs and can make a speech-recognition and control in communication networks more affordable. Additionally, there is another advantage that the loss of power or receipt of a physical impact of a mobile station contemplated by the present invention does not risk the loss of data as with conventional mobile stations. Moreover, the purchase of a new mobile station does not require the user to reprogram data as with conventional mobile stations.

Regarding claims 4, 26, 34, 40, 48 and 59, Lunsford et al. disclose all the limitations in claim 1, 23, 36, 44 and 56 respectively. However, Lunsford et al. do not disclose the method wherein the network-based communication service is a voice dialing service, the voice dialing service enabling a user to use number dialing at a network server.

In the same field of endeavor, Holt et al. disclose the method wherein the network-based communication service is a voice dialing service, the voice dialing service enabling a user to use number dialing at a network server ([0060] to [0061]).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the personal information device of Lunsford et al. by specifically including the network-based communication service is a voice dialing service, the voice dialing service enabling a user to use number dialing at a network server, as taught by Holt et al., the

motivation being in order to reduce network costs and can make a speech-recognition and control in communication networks more affordable. Additionally, there is another advantage that the loss of power or receipt of a physical impact of a mobile station contemplated by the present invention does not risk the loss of data as with conventional mobile stations. Moreover, the purchase of a new mobile station does not require the user to reprogram data as with conventional mobile stations.

Regarding claims 5, 27, 35, 41, 49, 60 and 61, Lunsford et al. disclose all the limitations in claims 1, 23, 33, 36, 44 and 56 respectively. However, Lunsford et al. do not disclose the method wherein the network-based communication service is an automated communication service that does not require voice commands.

In the same field of endeavor, Holt et al. disclose the method wherein the network-based communication service is an automated communication service that does not require voice commands ([0060] to [0061]).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the personal information device of Lunsford et al. by specifically including the network-based communication service is an automated communication service that does not require voice commands, as taught by Holt et al., the motivation being in order to reduce network costs and can make a speech-recognition and control in communication networks more affordable. Additionally, there is another advantage that the loss of power or receipt of a physical impact of a mobile station contemplated by the present invention does not risk the loss

of data as with conventional mobile stations. Moreover, the purchase of a new mobile station

does not require the user to reprogram data as with conventional mobile stations.

6.   Claims 6-7 and 62-63 are rejected under 35 U.S.C. 103(a) as being unpatentable over

Lunsford et al. (Pub. No: 2002/0065041) in view of Holt et al. (Pub. No: 20050113074) and

further in view of Cheung (Pub. No: 2004/0024647).

Regarding claims 6 and 62, the combination of Lunsford et al. and Holt et al. disclose all

the limitation in claims 5 and 56 respectively. However, the combination of Lunsford et al. and

Myers do not disclose the method wherein accessing the automated communication service

results in an automatic playing of a prerecorded message.

In the same field of endeavor, Cheung discloses the method wherein accessing the

automated communication service results in an automatic playing of a prerecorded message

([0044]).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the

invention was made to modify the personal information device of the combination of Lunsford et

al. and Holt et al. by specifically including accessing the automated communication service

results in an automatic playing of a prerecorded message, as taught by Cheung, the motivation

being in order to notify a customer of the occurrence of an event.

Regarding claims 7 and 63, the combination of Lunsford et al. and Holt et al. disclose all

the limitation in claims 5 and 56 respectively. However, the combination of Lunsford et al. and

Myers do not disclose the method wherein accessing the automated communication service

results in an automatic registering of a vote.

In the same field of endeavor, Cheung discloses the method wherein accessing the automated communication service results in an automatic registering of a vote ([0044]).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the personal information device of the combination of Lunsford et al. and Holt et al. by specifically including accessing the automated communication service results in an automatic registering of a vote, as taught by Cheung, the motivation being in order to notify a customer of the occurrence of an event.

7.   Claims 20 and 32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lunsford et al. (Pub. No: 2002/0065041) in view of Kumar et al. (Pub. No: 2003/0081758).

Regarding claims 20 and 32, Lunsford et al. disclose all the limitations in claims 1 and 29 respectively. However, Lunsford et al. do not disclose the method wherein the transmitting of the dialing signal occurs over a wired connection with the mobile communication device.

In the same field of endeavor, Kumar et al. disclose the method wherein the transmitting of the dialing signal occurs over a wired connection with the mobile communication device ([0021] to [0022]).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the personal information device of Lunsford et al. by specifically including the transmitting of the dialing signal occurs over a wired connection with the mobile communication device, as taught by Kumar et al., the motivation being in order to enable personal digital assistant to quickly and accurately transmit stored telephone numbers directly to other communication device containing a dialing device.

Conclusion

8.   Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

9.   Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dai A Phuong whose telephone number is 571-272-7896. The examiner can normally be reached on Monday to Friday, 9:00 A.M. to 5:00 P.M..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nguyen Duc can be reached on 571-272-7503. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Dai Phuong
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